

REMARKS

In the outstanding Office Action, claims 19-63 were presented for examination. Claims 46-62 were withdrawn, according to the Office action summary. Claims 1-45 were rejected for obviousness-type double patenting over Delrieu Patent No. 6,319,507 ("Delrieu '507" hereinafter) under 35 USC §103.

The Office Action has been most carefully studied. In this amendment applicant has canceled claims 46 and 63 without prejudice, has amended claims 22, 47, 49-53, 56, 59 and 61-62 for reasons which are explained below, and has added new claims 64-65 distinctly claiming the invention. Accordingly, as will be discussed in detail below, it is believed that the application is clearly in condition for allowance.

Claim Numbering/Claims Withdrawn

The second claim numbered 62, "Gel beads...", has been renumbered 63 in applicant's file, and has been understood by applicant to have been withdrawn from consideration, along with apparatus claims 46-62, as being drawn to nonelected subject matter. Any inconvenience to the Office resulting from minor informalities in applicant's claim numbering and references to claim numbers are regretted.

Abstract

A replacement abstract is filed herewith more particularly describing disclosed embodiments of the subject matter now claimed.

Specification

Page 9 of the specification has been amended to overcome the minor deficiency therein, in accordance with the Examiner's suggestion, which suggestion is greatly appreciated by applicant.

Claim Amendments

Claim 22 has been amended for readability, without narrowing and to make explicit language that was inherent. Claims 46 and 63 have been cancelled. New dependent claim 64 has been added directed to the product of the method of claim 19. It is believed clear that the invention of claim 64 is not distinct from the invention claimed in claim 19. See MPEP 806.05(f). New apparatus base claim 65 has been added to replace claim 46, and relevant ones of claims 47-62 have been amended to depend from new base claim 65.

Apparatus claim 65 has been carefully written to relate to the same invention as base claim 19 from which it depends. Thus, for example, apparatus claim 65 claims the apparatus as it is employed to perform the process of claim 19 so that the apparatus, as claimed could not be used to perform a materially different process at the same time. Similarly, the recitation of apparatus in method claim 19 is such that it is believed improbable that the method would be performed on materially different apparatus from that recited.

In some respects, claim 65 may be broader than canceled claim 46. It will be

understood that any narrowing of claim 65 with respect to now-cancelled claim 46, should there be any, which applicant does not believe there is, is made for the purpose of meeting Patent Office requirements regarding unity of invention, not for reasons related to patentability. Similar considerations carry through to the claims whose dependencies have been amended from 46 to 65.

Enablement Under 35 USC §112

The Office has rejected claims 1-32 and 33-45 for alleged lack of enablement under 35 USC §112. Applicant respectfully traverses this rejection and requests reconsideration and withdrawal of the rejection.

The standard for determining whether the specification meets the enablement requirement postures the question: "Is the experimentation needed to practice the invention undue or unreasonable?" See the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The Office has failed to offer any standard for determining whether applicant's specification is enabling which, in applicant's view, it is. Furthermore, the Office has made no showing that undue experimentation would be required to practice the invention claimed in any of claims 1-32 or 33-45 which, in applicant's view, it would not. For these reasons alone, the rejection is believed unfounded and should therefore be withdrawn.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and MPEP 2164(01(a)). Other than the breadth of the claims, the Office has not addressed any one of these factors, providing further reason why the rejection is unfounded and should be withdrawn, in applicant’s view.

Furthermore, applicant’s specification provides ample support for the broader scope of the invention which support is not limited to gels employing restraining polymers. Nevertheless, embodiments that do employ restraining polymers may be particularly advantageous, as is described in applicant’s specification. Some examples of disclosures not limited to the inclusion of a restraining polymer include, *inter alia*,

Still further, the description of the process and apparatus embodiments of applicant's invention illustrated in Figures 6-7, and elsewhere in applicant's specification is not limited to gels employing a restraining polymer, although the described methods and apparatus are particularly useful for preparing such gels. The nature of the methods and apparatus and the predictability of the arts relevant to such methods and apparatus is believed by applicant to be such that one skilled in the art would recognize, or have reason to believe, that other gels, including gels lacking a restraining polymer, some of which are described in applicant's background, might be employed and could be tried without requiring undue experimentation. This is not to say or imply that applicant's novel solutions to the unique problems of making gel beads containing restraining polymers are in any way suggested by the art.

The two paragraphs of the specification at page 37, line 18 to page 38, line 2 describe the incorporation of organic-solvent-laden porous particles in cosmetic gel beads without mention of or reference to a restraining polymer. In the context of these two paragraphs and the discussion in the immediately preceding two paragraphs, one skilled in the art would see no requirement to include a restraining polymer to solve the problem of incorporating an organic solvent in the bead. Of course, a restraining polymer could be included, if desired, to retain an active agent or provide other useful function such as are described in applicant's specification but it would not be essential in the context.

Similarly the statement in the paragraph at page 38, lines 24-27 regarding the entrainment of a liquid source of hot gel solution in a controlled flow of cool oil neither alludes to nor suggests that a restraining polymer is required in the gel solution (although a restraining polymer could be employed).

Similar comments may be made about the description at page 39, line 27 to page 40, line 13, of the method and apparatus illustrated in Figures 6-7. Nothing about these disclosures limits them exclusively to gel beads containing a restraining polymer and nothing about the objectives of the method and apparatus described in those paragraphs calls for the employment of a restraining polymer, although of course the general context of the specification, including for example, the statement at page 40, lines 15-16, makes it clear that a restraining polymer can be employed.

In light of these and other disclosures in the specification and drawings, it is believed clear that the Office's statement as to the lack of disclosure "a broader method unlimited by the addition of the restraining polymer" is incorrect. Such broader method is indeed disclosed, and one of ordinary skill in the art would not have to indulge in undue experimentation to practice it, in applicant's view.

35 USC §103 Double Patenting Rejection

A terminal disclaimer is filed herewith to overcome the obviousness rejection based on the judicially created double patenting doctrine. Applicant admits that at least

one claim meets the requirements of the doctrine, but does not admit that all claims meet it.

In view of the above amendments and the discussion relating thereto, it is respectfully submitted that the instant application, as amended, is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's representative would be helpful in the advancement of the prosecution, they are invited to call the telephone number below for an interview.

Respectfully submitted,

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